

III. REMARKS

Claims 1-4, 7-8 and 15 were rejected under 35 U.S.C. 103 as being unpatentable over Ejzak (US 6,721, 565) in view of Lautenschlager (US 6,321,096), and Claims 5-6, 9-14 and 16-19 were rejected under 35 U.S.C. 103 as being unpatentable over Ejzak in view of Lautenschlager and Forslow (US 2003/0039237) for reasons set forth in the Office Action.

The following argument is presented to overcome the foregoing rejections, and to show the presence of allowable subject matter in the claims. Various ones of the claims have been amended, and new claims are presented, to distinguish the claimed subject matter from the teachings of the cited as applied in the foregoing rejections.

With respect to the subject matter set forth in the independent claims, both Ejzak and Lautenschlager fail to give any indication of arranging message transmission to the first network offering circuit switched services in response to a failure to transmit the message via the second network if an error message is received from the second network. Instead, Lautenschlager in col. 5, lines 12-43 discloses that the control unit of the terminal (particularly col. 5, lines 16, 27, 30, and CONTR of Fig. 2) may transmit a warning message to a user of the terminal (via a user interface unit MMI), as taught in col. 5, lines 27-33 and Fig 2. Hence, the operation of Lautenschlager, considered alone and in combination with Ejzak, is very different from the presently claimed subject matter, and there is no suggestion of the functionality of the present invention as currently claimed.

As regards the Ejzak et al, Ejzak, considered alone and in combination with Lautenschlager, does not teach triggering of a handover in response to the need to transmit one of the packets. Instead, a handover is triggered in response to the criteria mentioned in column 11, lines 39-41, and a need for message transmission is not part of the criteria. Furthermore, it is well known in the art that handovers are performed to enable continuous service for mobile devices, so that a handover is performed whenever

the currently serving base station can no longer provide adequate service for the mobile terminal. It is also known that a call may exist and may be handed over between base stations independently of the occurrence of transmission of packets utilizing the call or transmission context. This is also evident from Ejzak; there is no indication of a specific check, as a precondition for triggering a handover decision, or for transmission of a packet. Hence, the handover related features of Ejzak are not relevant for the presently claimed features related to message transmission.

Further, as disclosed on page 2, lines 9-13 of the present application, e.g. in GPRS messages, the messages may be transmitted without any existing call or packet data protocol context that would need to be handed over similarly to the call being handed over in Ejzak. Ejzak instead requires that there must be a call for the handover to occur (col. 14, lines 18-19).

Also for the reasons above, Ejzak fails to disclose the currently claimed feature of transmitting the message to the circuit-switched network in response to a failure to transmit the message via the packet-switched network. Ejzak merely discusses handover of a call, i.e. does not give any indication of the changing of transmission of a single packet via a circuit-switched network, if this message could not be successfully transmitted via the packet-switched network. Ejzak does not provide any disclosure indicating a transmission arrangement for switching over to circuit-switched side services if this single message could not be transferred via the packet-switched side. Instead, Ejzak merely discusses switching the call by which data may be transferred. Also, Ejzak completely fails to cover the possibility of transmitting messages in case of no call or transmission context even existing in the terminal.

Since both Lautenschlager and Ejzak fail to show or suggest significant aspects of the presently claimed subject matter, as noted above, there would be no motivation to combine their teachings. Further, the Lautenschlager disclosure (col. 8, lines 9-11) on the

mobile terminal status in a home location register of the core network changing to "detached" has no relevancy as regards the currently claimed feature of "checking, by the mobile station, in response to the need to transmit at least one message, if the mobile station is attached to the second network". The disclosed change of status in core network register is not relevant as regards a specific checking step to check if the mobile station is attached to the second network, and further as regards such checking step carried out by a mobile station. Also the remaining portion of the Lautenschlager disclosure fails to disclose the currently claimed checking features in the mobile terminal.

Furthermore, the cited Lautenschlager disclosure is about core-network routing of connection requests to a mobile terminal (i.e. incoming call requests), which is completely separate and different from arranging transmission of a message by a mobile terminal.

Hence, Lautenschlager fails to provide such additional teaching disclosing all features not taught by Ejzak. Thus, these two references, even upon an attempt to combine their respective teachings, fail to teach the present invent as set forth in the present claims.

As noted in the previously submitted responses, the present invention is directed to a problem in systems having both packet-switched networks that support a transferring of messages, for instance GPRS networks supporting transfer of SMS short messages, and other packet-switched networks that do not support a transferring of such messages. In these situations the terminal (mobile station) does not know if the current packet-switched network supports the transfer of such messages. The present invention provides for a selection of a communication network and a message transfer procedure that enables transmission of messages, which are intended to be transmitted via a packet-switched network, to be transmitted also in systems that do not support short message transmission via a packet-switched network (present specification on page 3 at lines 8-15).

The teaching of Ejzak relates to the switching of an active cell to another network, i.e. a handover, and is not relevant to a teaching of the presently claimed features related to transmitting a message or performed in response to a need to transmit a message. Since a handover by definition is only performed for an ongoing call, a call must be active in order for the handover procedures to occur (see also col. 14, lines 18-29 of Ejzak).

The cited portions of Ejzak merely disclose a handover from a packet-switched network to a circuit-switched network as a response to a current RF path being of poor quality, this being detected based on channel measurements. There is no suggestion of detecting a failure of transmission of a message in the present claim context (e.g. based on a received error message from the network), and no suggestion of further actions, in particular of transmission of the message to a circuit-switched network in response to such failure, i.e. after an unsuccessful attempt to transmit the message first via the first packet-switched network.

If Lautenschlager is combined with Ejzak, the combination of these two teachings would fall to show or suggest the current combination of features in the present independent claims. Lautenschlager deals with establishment of a switching of network-side routing of future incoming calls to a mobile terminal and, therefore, would not be considered for an attempted solution to solve a problem or to enhance functionality related to message transmission from a terminal.

In the case of Ejzak, the intent is to provide communication via the second network having the packet communication capability, independently of the relative signal strength of the two networks, as long as there is sufficient signal strength to maintain communication via the second network. In Lautenschlager, the intent is to employ whichever network has the higher signal strength. Since the systems of these two references operate with different philosophies of operation, an artisan in the

communication field would avoid any attempted combination of their teachings, this negating any motivation for combination of the two teachings.

Lautenschlager discloses a switchover method between two different wireless networks, in particular between a GSM network and a DECT network for a mobile terminal moving between these networks. The mobile terminal is configured to initiate a switchover to another type of these networks if the terminal has moved to an area of another network. This is detected on the basis of the field strength of a selected radio network base station falling below a minimum value (column 5, lines 12-20).

The combination of these two references fails to disclose the checking of the attachment to the packet-switched network. The cited RF measurements taught both by Ejzak and Lautenschlager are for completely different purpose, namely for determining if handover or switch-over is necessary to maintain a high quality of transmission. Further, there is no indication towards arranging such check in response to a need to transmit a type of message. Instead, such measurements are typically periodically performed. Further, the features of Lautenschlager focus on arranging switching routing of future incoming calls to a mobile terminal (col. 4, lines 62-64). Hence, a man skilled in the art could not arrive at this claimed feature on the basis of the cited documents.

As a further point of argumentation, it is noted on page 3 of the Office Action, beginning at the middle of the page, that the examiner discusses the switching processes of Lautenschlager and concludes that checking the RF path quality (last two lines of the page) to determine conditions for handover is the same as checking if the mobile station is attached to the second network ("second network" is subject matter of the rejected claims) and is transmitting via the second network because poor signal quality has the same effect (Action, page 4 at lines 1-6) as detaching the mobile station from a network.

It is urged, respectfully, that this conclusion of the examiner is erroneous. In the present specification (page 2 at lines 15-30), the issue is raised as to whether a network can support a particular format of communication. For example a communication system that does not support the short message service (SMS) will fail to communicate such a message even though there is optimum signal to noise (SNR) power ratio. The specification (page 3 at lines 8-15) discusses two signal formats, namely, the packet switched network and the SMS. One can switch between networks (lines 16-32) to obtain a desired communication. This discussion in the specification applies to communication links operating at high SNR with good quality signals. Therefore, the examiner's analogy with network switching based on the criteria of adequate SNR is misleading, and should not be a basis for rejection of the claims. It also shows that there could be no motivation to combine the references, because the suggested motivation is based on a false premise.

It is noted further that, upon combining the teachings of Forslow with the teachings of Ejzak and Lautenschlager, the foregoing analysis still applies. Accordingly, the foregoing argument applies to overcoming all of the claim rejections, and also shows the presence of allowable subject matter in the rejected claims as well as in the newly presented claims.

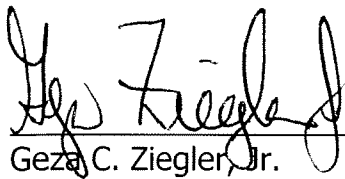
For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

10/037,272

Response to the Office Action mailed 31 May 2007

The Commissioner is hereby authorized to charge payment for the four additional claims including three independent claims (\$800) as well as any other fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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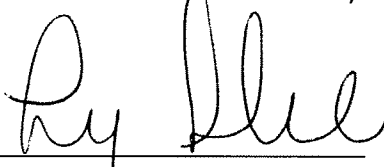
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I hereby certify that this correspondence is being transmitted electronically, on the date indicated below, addressed to the Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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